

## ***REMARKS***

Claims 1-24, 27 and 30-47 are pending in the present application. By this reply, claims 25-26 and 28-29 have been cancelled and new claims 30-47 have been added. Claims 1, 14, 30 and 39 are independent claims.

### **35 U.S.C. § 112, First Paragraph, Rejection**

Claims 25-26 and 28-29 have been rejected under 35 U.S.C. § 112, first paragraph, as being directed to a disclosure which is not enabling. Without acquiescing to any of the Examiner's allegations made in rejecting these claims, to expedite prosecution only, these claims have been canceled. Accordingly, the rejection is moot and should be withdrawn.

### **35 U.S.C. §§ 102 and 103 Rejections**

Claims 1-4, 7-21, 25-26 and 28-29 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bish et al. (U.S. Patent No. 5,235,585) (hereinafter Bish). Claims 5-6 and 22-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bish as applied to the claims above. Claims 24 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bish as applied to claims 1-23, 25-26 and 28-29 above, and further in view of Applicant's disclosed background art. These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

Regarding independent claim 1, the Examiner equates Bish's "secondary storage region" to Applicant's variable supplementary spare area (see column 4, lines 16-21 of Bish). However, this is improper since the secondary storage region in Bish implies only a "unit" to replace the defective block. Furthermore, the primary and secondary storage regions correspond to the list of defects such as a PDL and an SDL discussed in Applicant's disclosed related art. Moreover, Bish does not disclose or suggest "a location information of the supplementary spare area" being of a variable size and using "the supplementary spare area as a user data area after formatting" as recited in claim 1.

The above arguments apply equally to independent claim 14 which contains similar subject matter as claim 1. Furthermore, regarding claim 14, Bish does not teach or suggest, *inter alia*, "transferring secondary defect information with a new PDL of the defect management information according to the instruction at least to use the supplementary spare area as a user data area after formatting", as recited in claim 14.

Accordingly, the invention as recited in independent claims 1 and 14 and their dependent claims (due to their dependency) are patentable over the applied reference(s), and the rejections should be withdrawn.

**NEW CLAIMS**

Claims 30-47 emphasize the distinguishing features of Applicant's invention over the prior art of record and are thus allowable over the prior art of record.

**CONCLUSION**

For the foregoing reasons and in view of the above clarifying amendments, Applicant respectfully requests the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicits an early issuance of a Notice of Allowance.

The Examiner is respectfully requested to enter this Amendment After Final Rejection, in that it raises no new issues but merely places the claims in a form more clearly patentable over the references of record. In the alternative, the Examiner is respectfully requested to enter this Amendment After Final Rejection in that it reduces the issues for appeal.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant(s) respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and 1.17 for a three month extension of time in which to respond to

the Examiner's Office Action. **The Extension of Time Fee in the amount of \$950.00 is attached hereto with the concurrent filing of a Notice of Appeal.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASH & BIRCH, LLP

By Seth L. Lane #41,458  
Joseph A. Kolasch, #22,463

P.O. Box 747  
Falls Church, VA 22032-0747  
(703) 205-8000

JAK/<sup>an</sup>EHC:lmh